UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,184	08/06/2003	Murali M. Karamchedu	109166-130890	9182

25943   7590   10/15/2008
SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

EXAMINER
ENG, DAVID Y

ART UNIT	PAPER NUMBER
2455	

MAIL DATE	DELIVERY MODE
10/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/635,184
Filing Date: August 06, 2003
Appellant(s): KARAMCHEDU ET AL.

Steven J. Prewitt
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 30, 2008 appealing from the Office

action mailed April 22, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,028,075	Morris	4-2006
6,199,081	Meyerson et al.	3-2001
7,146,564	Kim et al.	12-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112, 2nd paragraph

In view of Appellants' remarks in the brief, the Section 112, 2nd paragraph Rejection of claims 1 and 3-48 is hereby withdrawn.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 3-48 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Morris (USP 7,028,075) in view of Meyerzon et al. (USP 6,199,081).

Claims 3-48 stand or fall with claim 1

Appellants provide arguments for claim 1 only. Claims 3-48 therefore stand or fall with claim 1.

Scope of the Invention Claimed Interpreted In Light of the Specification

Appellants' invention is a semantic qualification logic 108 shown in Figure 1. The qualification logic 108 implements a process shown in Figure 8 (see line 3 at page 3 of Appellants' brief). Figure 8 shows that the process has three steps corresponding to the three steps recited in independent claim 1. Appellants further identify, in the "**Summary of the Invention**" of the brief (see the first two paragraphs on page 3 of the brief), the supports of each of the steps in the specification.

Step 1 of claim 1

Step 1 recites: determining by a computing device a context to be applied to an electronic mail message;

Support of Step 1 in the Specification

page 7, line 5-9 and

page16, line 21 to page 17, line 14.

In the excerpts identified above, the specification fails to identify **the computing device** recited in step 1. The specification fails to explain **how to determine a context** to be applied to an electronic mail message. The specification fails to identify **a context** to be applied to an electronic mail message shown in Figure 3 so that one of ordinary skill in the art understands what context Appellants are referring. The specification fails to identify the "context" based upon the content of the message body; the "context"

based on the subject line of the message, etc. (see page 17, line 3-14). The

specification fails to explain how to identify those contexts.

The identified excerpts merely give the definition of the words "contextualization"

and "context". Step 1 at best merely recites generating an electronic message or email.

Step 1 is taught by Morris ('075)

In column 5, lines 34-38, Morris teaches creating a HTML email message. In the

communication filed on 1/28/2008 (the last 2 lines in the second paragraph of page 15),

Appellants agreed with the Examiner.

Step 2 of claim 1

Step 2 recites: identifying by a computing device one or more elements within the

electronic mail message based at least in part upon the context;

Support of Step 2 in the Specification

Page 19, line 3-21.

Appellants identified the excerpt in line 3-21 of page 19 for the support of step 2.

The excerpt describes all three steps of claim 1. Only the description in line 9-12 of

page 19 (block 802) is related to step 2. The excerpt does not describe how to identify

one or more elements within the electronic mail message based upon the context

determined in step 1.

Step 2 is taught by Meyerzon ('081)

In line 35-44 of column 1, Meyerzon teaches that a HTML document contains

metadata and metatag. In lines 1-17 of column 3, Meyerzon further teaches that "a

meta-tag "Author" may identify meta-data in the document that identifies the author (For

example, John Smith) of the document. For example, <AUTHOR> John Smith

</AUTHOR>. Meyerzon therefore teaches identifying an element (John Smith) within

the electronic mail message so that the element, John Smith, is **associated** with a

semantic qualifier or meta-tag <AUTHOR> as recited in step 3.

Step 3 of claim 1

Step 3 recites: associating by a computing device one or more semantic

qualifiers with the one or more elements to provide contextualization of at least a portion

of the electronic mail message.

Support of Step 3 in the Specification

Page 7, line 17-22 and

Page 9, line 1 to page 10, line 2.

The excerpts describe embedding semantic qualifiers represent metadata tag

pairs within electronic messages (See line 16-17 of page 9 of the specification). Figure

6a of the instant specification shows an example of such an electronic message.

Attention of the Board is respectfully directed to the line contains: **<CARE EPISODE**

1><PATIENT> Bob Jones**</PATIENT>** was examined today. The line shows that a

semantic qualifier representing metadata tag pairs (**<PATIENT>** and **</PATIENT>**)

associated with a metadata or element (Bob Jones) of an electronic message.

Step 3 is taught by Meyerzon ('081)

Reference is made to the explanation in the section above entitled **Step 2 is**

taught by Meyerzon ('081). The explanation is incorporated herein by reference

thereto.

Morris teaches a HTML electronic mail. Meyerzon teaches that HTML document

contains metatag pairs associating with elements within the HTML document. From the

teaching of Meyerzon, one of ordinary skill in the art should readily recognize that the

HTML electronic mail of Morris contains metatag pairs associating with elements within

the HTML document. Step 1 and step 2 are inherent steps for generating a HTML

document because without them a HTML document could not be generated.

The Kim patent (7,146,564) which is not applied is cited to show another HTML

document having metatag pairs for identifying elements within the HTML document.

(10) Response to Argument

On page 10 of the brief, Appellants merely describe what they understand of the

teaching of the applied references and how they would combine them.

In the first full paragraph of page 11, Appellants read limitations from the

specification to the claims.

In the second full paragraph of page 11, Appellants contend that the Examiner

overlooks the limitation of "a context to be applied to an electronic mail message" and

"to provide contextualization of at least one of the electronic mail message and the one

or more text elements". Firstly, Appellants did not provide any arguments as to why this

limitation is patentable distinct over the applied art. Simply pointing out what a claim

requires with no attempt to point out how the claims patentably distinguish over the prior

art does not amount to a separate argument for patentability. Secondly, the Examiner

does address the limitation. Appellants fail to explain why the rejection is in error.

Further with respect to the second limitation, the second limitation is the result of

associating a semantic qualifier with an element. The combination of Morris and

Meyerzon has the limitation because the combination teaches associating a semantic

qualifier with an element.

In the last paragraph of page 11 of the brief, Appellants contended that Morris

and Meyerzon do not provide for the identification of one or more elements within the

message based at least in part upon the context (Appellants' emphasis). Again,

Appellants did not explain why this feature is patentable distinct over the applied

reference. Further, as set forth in the rejection above, the specification does not explain

what "context to be applied to an electronic mail message" is and how to identify the

elements within the electronic message based upon the context. The Examiner asserts

that the combination of the applied references does have the limitations because the

end result of the Morris-Meyerzon combination is a HTML electronic mail message

having semantic qualifier/element association, similar to Appellants' Figure 6, to provide

contextualization of at lest a portion of the electronic mail message as required in the

last step of claim 1. The first two steps of claim 1 are inherent steps because without

them the last step is impossible.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/DAVID Y. ENG/
Primary Examiner, Art Unit 2455

Conferees:
Saleh Najjar
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2455

/Zarni Maung/
PRIMARY PATENT EXAMINER
GROUP ART UNIT 2451

/saleh najjar/

Supervisory Patent Examiner, Art Unit 2155